REMARKS

The present application was filed on March 31, 2004 with claims 1 through 27 Claims 1 through 27 are presently pending in the above-identified patent application. Claims 1, 21 and 27 are proposed to be amended.

In the Office Action, the Examiner rejected claims 1-6, 15-16, 21-24 and 26-27 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-7, 9-10, 13, 17-19, 21-22 and 25 of co-pending application serial number 10/723,416. The Examiner objected to claims 4, 6, and 23-24 as having substantial duplicates. In addition, the Examiner rejected claims 2 and 3 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claim 27 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1-17 were rejected under 35 U.S.C. §102(b) as being anticipated by Kanevsky et al. (United States Patent No. 5,774,525).

Double Patenting

The Examiner rejected claims 1-6, 15-16, 21-24 and 26-27 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-7, 9-10, 13, 17-19, 21-22 and 25 of co-pending application serial number 10/723,416. The Examiner notes that the "most pertinent correlation" is between the independent claims of each application. First, Applicants note that neither application has allowable claims, so the double patenting rejection is premature. The ultimate scope of the claims in each application remains to be seen. In any event, in their present form, the independent claims of the present application are directed to methods and systems for *evaluating a password proposed by a user*. Meanwhile, the independent claims of co-pending application serial number 10/723,416 are directed to methods and systems for *authenticating a user*. While both applications may be based on the correlation of information with users, the application and recited steps are different. Authentication is only one application of the present invention.

Applicants respectfully request withdrawal of the double patenting rejection. In the alternative, Applicants respectfully request deferral of the double patenting rejection until at least one of the applications is allowed.

Formal Objections and Rejections

The Examiner objected to claims 4, 6, and 23-24 as having substantial duplicates. For example, the Examiner asserts that claims 4 and 6 are substantial duplicates of each other Claim 4 recites that "wherein said proposed password is comprised of a proposed answer and a

proposed hint and wherein said one or more predefined correlation rules evaluate whether said
proposed answer can be *correlated with said proposed hint in a particular relation*," while claim 6
recites that "wherein said proposed password is comprised of a proposed answer and a proposed
hint and wherein said one or more predefined correlation rules evaluate whether said proposed
answer can be *obtained from said proposed hint*."

Applicants submit that the highlighted text emphasize the different limitations of
each claim. Claim 4 emphasizes the correlation with a particular relation, while claim 6 emphasizes
that the answer can be *obtained from* the hint. Applicants respectfully request withdrawal of the
objection to claims 4, 6 and 23-24.

The Examiner rejected claims 2 and 3 under 35 U.S.C. §112, second paragraph, as being
indefinite for failing to particularly point out and distinctly claim the subject matter that applicant
regards as the invention. In particular, the Examiner asserts that the terms "qualitatively correlated" and
"quantitatively correlated" are relative terms that render the claim indefinite.

Applicants submit that the term "qualitatively correlated" is not a relative term, and
furthermore that this term is well understood by those of ordinary skill in the art. The term "qualitative"
is defined on Dictionary.com as "pertaining to or concerned with quality or qualities." In the original
specification, on page 9 (emphasis added), it is taught that:

> A test is performed during step 430 to determine if the
> answers or reminders (or both) are correlated with the user, discussed
> below in conjunction with FIGS. 13 through 18. In one implementation,
> one or more correlation rules may be defined to evaluate whether a given
> answer is correlated with the user. For example, if a user selects a
> telephone number of a person, the information extraction analysis
> performed during step 430 can determine if there is a predefined
> relationship between the owner of the telephone number and the user,
> such as a family member (self, sibling or parent), co-author, colleague or
> member of the same household *(qualitative correlation rule)*. The
> analysis correlates the number to the person by analyzing the number of
> hits obtained by using a search engine (such as Google.com or
> Orkut.com) where both the person and number appear on the same page.
> If the number of hits is higher than a chosen threshold, then a positive
> correlation is said to exist. Alternatively, the information extraction
> analysis may also use specialized web databases such as
> www.anywho.com that allow retrieval of information associated with a
> particular telephone number. The metric in this case is a positive match
> between the user's answer and the match against the phone entry.

Likewise, Applicants submit that the term "quantitatively correlated" is not a relative term, and furthermore that this term is well understood by those of ordinary skill in the art. The term "quantitative" is defined on Dictionary.com as of or pertaining to the describing or measuring of quantity." In the original specification, on the bottom of pages 6-7 (emphasis added), it is taught that:

> As another example, if a user selects the jersey number of a sports figure and the information extraction techniques reveal that the user is a fan of the sports team on which the sports figure stars, then that selection would be disallowed. This correlation may be *quantitatively weighted*, such that if only one correlation is found, the answer may still be allowed, however if many correlations are found, then the answer is disallowed. Such correlation information may be implemented as one or more correlation rules that are evaluated during the enrollment phase, as discussed further below in conjunction with FIG. 4.

Applicants submit that given the basic understanding of the terms "qualitatively correlated" and "quantitatively correlated," as well as the above teachings, a person of ordinary skill in the art can make and use the inventions defined by claims 2 and 3 to employ predefined correlation rules (to) ensure that answers to user selected questions cannot be qualitatively (or quantitatively) correlated with the user.

Applicants respectfully request withdrawal of the rejection under Section 112.

Section 101 Rejection

Claim 27 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. As noted by the Examiner, claim 27 is directed to an article of manufacture. As recited in claim 27, the article of manufacture comprises one or more (novel) programs *on a machine readable medium*. Applicants submit that an article of manufacture is explicitly recognized by section 101 ("manufacture") and is in full compliance with *In re Warmerdam*, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Applicants note that the Federal Circuit was not even considering a claim directed to an article of manufacture in *In re Warmerdam*.

Applicants respectfully request withdrawal of the rejection under Section 101.

Section 102 Rejection of Independent Claims

Independent claims 1, 21 and 27 were rejected under 35 U.S.C. §102(b) as being anticipated by Kanevsky et al. With regard to claims 1, 21 and 27, the Examiner asserts the Kanevsky et al. disclose a method, apparatus and article of manufacture for evaluating a password proposed by a user, comprising: receiving said proposed password from said user (col. 10, lines 17-31); and ensuring that a correlation between said user and said proposed password does not violate one or more predefined

correlation rules (col 10, lines 32-49). Kanevsky et al. is directed to methods and apparatus utilizing dynamic questioning to provide secure access control. In the passages referenced by the Examiner, Kanevsky et al. is addressing a password challenge. This passage assumes that the user has already enrolled and previously provided a password. If the user provides the proper password and the voice matches, questioning is bypassed. Col 10, lines 28-31. If the user is questioned, it is based on questions that have been previously provided and stored in database 66. Id. at lines 32-49.

The present invention, on the other hand, is employed *during an enrollment process*, to ensure that a *proposed* password *cannot be* correlated with the user, as required by each independent claim, as amended. These amendments are supported, for example, by FIG. 4 (enrollment process) and the corresponding discussion. Kanevsky et al does not disclose or suggest ensuring that said user *cannot be correlated* with said *proposed* password based on one or more predefined correlation rules, as variously required by each independent claim, as amended.

Applicants respectfully request withdrawal of the rejection of the independent claims under Section 102.

Dependent Claims

Claims 2-20 and 22-26 are dependent on independent claims 1 and 21, respectively, and are therefore patentably distinguished over Kanevsky et al. because of their dependency from independent claims 1 and 21 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.
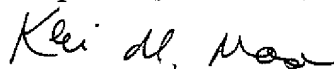
Conclusion

All of the pending claims following entry of the amendments, i.e., claims 1-27, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,

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